BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: John R. Hind et al.	:	Before the Examiner: Baum, Ronald
Serial No.: 09/316,804	:	Group Art Unit: 2131
Filed: May 21, 1999	:	
Title: METHOD AND APPARATUS FOR INITIALIZING MOBILE WIRELESS DEVICE	:	IBM Corporation P.O. Box 12195 Dept. T81/503 Research Triangle Park, NC 27709

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 17, 2004.

Signature

Serena Beller
(Printed name of person certifying)

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 2-4, 6, 8-10, 12, 14-16 and 18-22 are pending in the Application. Claims 4, 10 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 2-3, 6, 8-9, 12, 14-15 and 18-22 stand rejected.

IV. STATUS OF AMENDMENTS

The Appellants' response to the Office Action having a mailing date of July 30, 2003, has been considered, but the Examiner indicated that it did not place the application in condition for allowance because the Appellants' arguments were deemed unpersuasive. Appellants have submitted a supplemental 1.116 Reply, having a mailing date of May 5, 2004, amending objected claims 4, 10 and 16 to be written in independent form thereby adopting the Examiner's suggestion which requires only a cursory review by the Examiner.

V. SUMMARY OF INVENTION

The present invention allows the use of wireless devices containing a radio module to connect in a secure manner using digital certificates. Specification, page 10, lines 5-6. The present invention does not require manual entry of user identifiers, passwords or cryptographic keys. Specification, page 10, lines 6-7. The present invention also allows for efficient administration of secure devices within an

enterprise without creating additional administrative overhead for initializing the devices. Specification, page 10, lines 7-9.

In one embodiment of the present invention, a method for initializing a first device distributed with an embedded radio module using a server, the server having an embedded radio module, may comprise the step of sending an inquiry from the server to the first device using the embedded radio modules. Specification, page 15, lines 22-23. The method may further comprise returning, from the first device, a unique device identifier of the first device, to the server. Specification, page 15, lines 23-25. The method may further comprise creating, at the server, a public key, private key pair for the first device. Specification, page 16, lines 4-6. The method may further comprise creating, at the server, a device certificate for the first device, the device certificate having a unique hardware identifier associated with the first device and a public key associated with the first device. Specification, page 16, lines 6-8. The method may further comprise transmitting the private key, and the device certificate, and a public key of a certificate authority which signed the device certificate, to the first device. Specification, page 16, lines 8-17. The method may further comprise storing the private key in non-removable protected storage at the first device where the protected storage is write-only storage able to perform computations involving previously-written data. Specification, page 14, lines 14-16.

VI. ISSUES

Are claims 2-3, 6, 8-9, 12, 14-15 and 18-22 properly rejected under 35 U.S.C. §102(b) as being anticipated by Debry (U.S. Patent No. 6,314,521)?

VII. GROUPING OF CLAIMS

Claims 2, 8, 12, 14 and 18-22 form a first group.

Claims 3, 9 and 15 form a second group.

Claim 6 should not be grouped together and should be considered separately.

The reasons for these groupings are set forth in Appellants' arguments in Section VIII.

VIII. ARGUMENT

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. § 2131.

Appellants respectfully assert that Debry does not disclose "storing said private key in non-removable protected storage at said first device" as recited in claim 2 and similarly in claims 6, 8, 12, 14 and 18. The Examiner cites column 6, lines 28-32 and 66-67 of Debry as disclosing above-cited claim limitation. Paper No. 7, page 3. Appellants respectfully traverse and assert that Debry instead discloses that the printer decrypts the digital certificate using the certificate authority's public key and stores the digital certificate in a nonvolatile memory in the printing system. A nonvolatile memory does not correspond to a non-removable protected storage. Further, Debry does not disclose storing a private key in a non-removable protected storage. Thus, Debry does not disclose all of the limitations of claims 2, 6, 8, 12, 14 and 18, and thus Debry does not anticipate claims 2, 6, 8, 12, 14 and 18. M.P.E.P. § 2131.

Appellants further assert that Debry does not disclose "wherein said protective storage is write-only storage able to perform computations involving previously-written data" as recited in claim 2 and similarly in claims 6, 8, 12, 14 and 18. The Examiner cites column 6, lines 66-67 of Debry as disclosing the above-cited claim limitation. Paper No. 7, page 6. However, this language discloses the printer storing the digital certificate in a nonvolatile memory. A nonvolatile memory refers to

memory specifically designed to hold information even when the power is switched off. This is not the same as being able to perform computations involving previously-written data. Thus, Debry does not disclose all the limitations of claims 2, 6, 8, 12, 14 and 18, and thus Debry does not anticipate claims 2, 6, 8, 12, 14 and 18. M.P.E.P. § 2131.

Appellants further assert that Debry does not disclose "creating, at said first device, a public key, private key pair for said first device" as recited in claim 6. The Examiner cites column 6, lines 19-27 and 40-41 and column 8, lines 17-25 of Debry as disclosing the above-cited claim limitation. Paper No. 7, page 5. However, this language discloses that when a printer is manufactured, a unique data encryption key is built into the printer. Debry only discloses a unique data encryption key but does not disclose a public key, private key pair. Thus, Debry does not disclose all of the limitations of claim 6, and thus Debry does not anticipate claim 6. M.P.E.P. § 2131.

Appellants further assert that Debry does not disclose "returning, from said first device, a unique device identifier and said public key of said first device, to said server" as recited in claim 6. The Examiner cites column 6, lines 36-43 of Debry as disclosing the above-cited claim limitation. Paper No. 7, page 5. However, this language discloses that the printer sends a message containing the printer model and serial number, the printer's network address and a request for a digital certificate. This message does not contain a public key of the first device. Thus, Debry does not disclose all the limitations of claim 6, and thus Debry does not anticipate claim 6. M.P.E.P. § 2131.

Appellants further assert that Debry does not disclose "creating, at said server, a device certificate for said first device, said device certificate having said device identifier and said public key" as recited in claim 6. The Examiner cites column 6, lines 12-18 and column 9, lines 15-23 of Debry as disclosing the above-cited claim

limitation. Paper No. 7, page 5. This language in Debry discloses the certificate authority generating a unique public/private encryption key pair for the printer and builds a digital certificate having the fields that includes a distinguished name of the printer, the issuer's distinguished name, the public key, the issuer's digital signature, the validity period and a serial number. While the digital certificate includes a serial number that presumably was sent from the printer, the digital certificate does not include a public key that was sent from the printer as the printer never transmitted a public key to the certificate authority. Thus, Debry does not disclose all of the limitations of claim 6, and thus Debry does not anticipate claim 6. M.P.E.P. § 2131.

Appellants further assert that Debry does not disclose "wherein a copy of said certificate is stored in an enterprise database" as recited in claim 3 and similarly in claims 9 and 15. The Examiner recites column 6, lines 24-26 and 61-64 of Debry as disclosing the above-cited claim limitation. Paper No. 7, page 7. However, this language discloses a database at the certificate authority server that stores a new public key that was sent from the certificate authority to the printer. This language does not disclose storing a copy of a device certificate in an enterprise database. Thus, Debry does not disclose all of the limitations of claims 3, 9 and 15, and thus Debry does not anticipate claims 3, 9 and 15. M.P.E.P. § 2131.

As a result of the foregoing, Appellants respectfully assert that not each and every claim limitation was found within the cited prior art reference and thus claims 2-3, 6, 8-9, 12, 14-15 and 18-22 are not anticipated by Debry.

IX. CONCLUSION

For the reasons noted above, the rejections of claims 2-3, 6, 8-9, 12, 14-15 and 18-22 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 2-4, 6, 8-10, 12, 14-16 and 18-22.

Respectfully submitted,
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APPENDIX

2. A method for initializing a first device distributed with an embedded radio module using a server, said server having an embedded radio module, said method comprising the steps of:

sending an inquiry from said server to said first device using said embedded radio modules;

returning, from said first device, a unique device identifier of said first device, to said server;

creating, at said server, a public key, private key pair for said first device;

creating, at said server, a device certificate for said first device, said device certificate having a unique hardware identifier associated with said first device and a public key associated with said first device;

transmitting said private key, and said device certificate, and a public key of a Certificate Authority which signed said device certificate, to said first device; and

storing said private key in non-removable protected storage at said first device;

wherein said protected storage is write-only storage able to perform computations involving previously-written data.

3. A method as claimed in claim 2 wherein a copy of said certificate is stored in an enterprise database.

4. A method as claimed in claim 2 wherein a copy of said certificate is stored in an LDAP directory.

6. A method for initializing a first device distributed with an embedded radio module using a server, said server having an embedded radio module, said method comprising the steps of:

sending an inquiry from said server to said first device using said embedded radio modules;

creating, at said first device, a public key, private key pair for said first device;

storing, at said first device, said private key in non-removable protected storage;

returning, from said first device, a unique device identifier and said public key of said first device, to said server;

creating, at said server, a device certificate for said first device, said device certificate having said device identifier and said public key; and

transmitting said device certificate and a public key of a Certificate Authority which signed said device certificate to said first device;

wherein said protected storage is a write-only storage able to perform computations involving previously-written data.

8. A system for initializing a first device distributed with an embedded radio module using a server, said server having an embedded radio module, said system comprising:

a communications mechanism for sending an inquiry from said server to said first device using said embedded radio modules, and returning, from said first device, a unique device identifier of said first device, to said server;

a processor at said server for creating a public key, private key pair for said first device; and

a device certificate, created at said server, for said first device, said device certificate having a unique hardware identifier associated with said first device and a public key associated with said first device;

wherein said communications mechanism transmits said private key, and said device certificate, and a public key of a Certificate Authority which signed said device certificate, to said first device; and, said processor stores said private key in non-removable protected storage at said first device;

wherein said protected storage is write-only storage able to perform computations involving previously-written data.

9. A system as claimed in claim 8 wherein a copy of said certificate is stored in an enterprise database.

10. A system as claimed in claim 8 wherein a copy of said certificate is stored in an LDAP directory.

12. An initialization system, said system comprising:

a first device, said first device having an embedded radio module;

a server, said server having an embedded radio module;

a communications mechanism, said communications mechanism sending an inquiry from said server to said first device using said embedded radio modules;

wherein said first device creates a public key, private key pair for said first device, stores said private key in non-removable protected storage, and returns a unique device identifier and said public key of said first device, to said server;

said server creates a device certificate for said first device, said device certificate having said device identifier and said public key; and transmits said device certificate and a public key of a Certificate Authority which signed said device certificate to said first device;

wherein said protected storage is a write-only storage able to perform computations involving previously-written data.

14. A computer program product embodied in a machine readable medium for initializing a first device distributed with an embedded radio module using a server, said server having an embedded radio module, wherein said computer program product comprises the programming steps of:

sending an inquiry from said server to said first device using said embedded radio modules;

returning, from said first device, a unique device identifier of said first device, to said server;

creating, at said server, a public key, private key pair for said first device;

creating, at said server, a device certificate for said first device, said device certificate having a unique hardware identifier associated with said first device and a public key associated with said first device;

transmitting said private key, and said device certificate, and a public key of a Certificate Authority which signed said device certificate, to said first device; and

storing said private key in non-removable protected storage at said first device;

wherein said protected storage is write-only storage able to perform computations involving previously-written data.

15. The computer program product as claimed in claim 14 wherein a copy of said certificate is stored in an enterprise database.

16. The computer program product as claimed in claim 14 wherein a copy of said certificate is stored in an LDAP directory.

18. A computer program product embodied in a machine readable medium for initializing a first device distributed with an embedded radio module using a server, said server having an embedded radio module, wherein said computer program product comprises the programming steps of:

sending an inquiry from said server to said first device using said embedded radio modules;

creating, at said first device, a public key, private key pair for said first device;

storing, at said first device, said private key in non-removable protected storage;

returning, from said first device, a unique device identifier and said public key of said first device, to said server;

creating, at said server, a device certificate for said first device, said device certificate having said device identifier and said public key; and

transmitting said device certificate and a public key of a Certificate Authority which signed said device certificate to said first device;

wherein said protected storage is a write-only storage able to perform computations involving previously-written data.

19. The method as recited in claim 2, wherein communication between said first device and said server is performed in a wireless manner.

20. The system as recited in claim 8, wherein communication between said first device and said server is performed in a wireless manner.

21. The computer program product as recited in claim 14, wherein communication between said first device and said server is performed in a wireless manner.

22. The computer program product as recited in claim 18, wherein communication between said first device and said server is performed in a wireless manner.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John R. Hind et al.
Serial No.: 09/316,804 Art Unit: 2131
Filed: May 21, 1999 Examiner: Ronald Baum
For: METHOD AND APPARATUS FOR INITIALIZING MOBILE WIRELESS DEVICE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION - 37 CFR 1.192)

1. Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on March 26, 2004.

NOTE: "The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate." 37 CFR 1.192(a) (emphasis added).

2. STATUS OF APPLICANT

This application is on behalf of

- ☒ other than a small entity
- ☐ small entity

  verified statement:
  - ☐ attached
  - ☐ already filed

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

☐ small entity	$165.00
☒ other than a small entity	$330.00
Appeal Brief fee due	**$330.00**

CERTIFICATE OF MAILING (37 CFR § 1.8)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 5/17/04

Serena Beller
(Type or print name of person mailing paper)

Serena Beller
(Signature of person mailing paper)

4. EXTENSION OF TERM

NOTE: The time periods set forth in 37 CFR 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 CFR 1.191(d). Also see Notice of November 5, 1985 (1060 O.G. 27).

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(complete (a) or (b) as applicable)

(a) ☐ Applicants petition for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
☐ one month	$ 110.00	$ 55.00
☐ two months	$ 420.00	$ 210.00
☐ three months	$ 950.00	$ 475.00
☐ four months	$ 1,480.00	$ 740.00
Fee		

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured and the fee paid therefor of $_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request $_____

or

(b) ☒ Applicants believe that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicants have inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal Brief fee $330.00

Extension fee (if any) $0

TOTAL FEE DUE $330.00

6. FEE PAYMENT

☐ Attached is a check in the sum of $_____

☒ Charge Account No. 09-0461 (CR9-99-045) the sum of $330.00.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

☒ If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 09-0461 (CR9-99-045).

AND/OR

☒ If any additional fee for claims is required, charge Account No. 09-0461 (CR9-99-045).

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SIGNATURE OF ATTORNEY OR PATENT AGENT

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